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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Frank Dean

Filed: August 22, 2003

Serial Number: 10/646,138

Title: GOLF BAG CARRIER FOR
A MOTORCYCLE

Attorney Docket: MSH- 257

) Before the Board
) Of Appeals
)

) Examiner: Larson
)

) Group Art Unit 3727
)

) Cover Letter for Brief
)

) May 25, 2006
)


Commissioner for Patents
P. O. Box 1450
Alexandria Va 22313-1450

Dear Sir:

This is an appeal from the Office Action mailed January 11, 2006 finally rejecting claims 1 to 12. A notice of Appeal was timely filed on April 19, 2006 with the appropriate accompanying fee.

Please find enclosed a brief in support of the Notice of Appeal. The Commissioner is hereby authorized to charge a brief fee of \$250.00 under Fee Code 2402. The Appellant is a small entity.

Respectfully submitted,


Robert L. McKellar
Reg. No. 26,002
(989) 631-4551

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BRIEF ON APPEAL

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(C)(1)(i) REAL PARTY IN INTEREST

The real party in interest of the application being considered in this appeal is the inventor, Frank Dean.

(C)(1)(ii) RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present one that are likely to directly affect or be directly affected by the Board's decision in the pending appeal.

(C)(1)(iii) STATUS OF THE CLAIMS

Claims 1 to 12 are all the claims in the application. The Examiner has rejected all twelve claims under 35 USC §103(a). Claims 1 to 12 are the claims being appealed.

(C)(1)(iv) STATUS OF AMENDMENTS

claim 1 was amended in response to the first office action and that amendment is reflected in the appended claims. No additional amendments have been made.

(C)(1)(v) SUMMARY OF CLAIMED SUBJECT MATTER

This invention deals with a golf bag carrier for use on a motorcycle, the motorcycle having passenger foot pegs, page 2, line 28, page 4, line 1 and page 5, lines 27/28; an elongated mounting frame member, page 2, lines 11, 14, 15, 17/18, 19, and 22, page 3, lines 18, 20, 22, 23, 26, 27, and 30, page 4, lines 8, 11, 28, and 30; having an attachment means for attaching the mounting frame member to the motorcycle, page 2, lines 11/12, page 3, lines 20 and 31, page 4, lines 30/31; a first support member attached to the mounting frame member, page 2, lines 13, 14, 16, 21, 23/24, and 26/27, page 3, lines 21, 23, 30, and 32, page 4, lines 17 and 20, page 5, 31/32; a second elongated support member attached to the mounting frame member, page 2, lines 17, 18, 20/22, 23/24, and 26/27; page 3, lines 25/26, 18, 19, and 32, page 4, lines 4, 15, and 20, page 5, line 32.

(C)(1)(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected claims 1 to 12 under 35 USC 103(a) as being unpatentable over Slifka, U.S. 5,207,361 in view of Brown U.S. 6,698,635.

(C)(1)(vii) ARGUMENTS

The Examiner has rejected claims 1 to 12 under 35 USC 103(a) as being unpatentable over Slifka, U.S. 5,207,361 in view of Brown U.S. 6,698,635.

The appellant takes the position that the claims are not obvious with regard to the combination of the references.

The Appellant takes the position that Slifka teaches only a foot pad for a golf bag on a motorcycle, not a “carrier”. The so-called “carrier” of Slifka requires, in addition to the foot pad, a series of straps to hold the golf bag on the motorcycle. Slifka does not teach the strapless carrier of the instant invention, as there is nothing in Slifka that teaches the use of a carrier of the instant invention. The only common point between Slifka and the instant invention is that they both attach to a foot pedal of the motorcycle (and in the case of the instant invention, that is only one of the points of attachment). In addition, the “carrier” of Slifka requires that the golf bag be essentially vertical on the motorcycle and this mounting can cause problems with wind resistance and also with the movement of the bag owing to the movement of the wind around the motorcycle as it is moving. Further, the device of Slifka requires that the passenger foot pedal be modified wherein the device of the instant invention does not.

Now the Examiner brings in Brown to overcome the shortfalls with the Slifka device, to make the case that the device of the Brown reference can be used to teach rigidity and sturdiness to the Slifka device.

In summary, Slifka is not a “carrier” as is defined in the instant invention and substantial changes would have to be made to Slifka to provide a carrier for a golf bag of the nature of the instant device. Further, Brown also requires the use of straps to hold the golf bag in place.

With regard to paragraph 6 of the office action, the Appellant would state that it would not have been obvious to determine the appropriate angle that needed to be formed between the U-shaped support members aligned with the foot pegs and the longitudinal axis of the motorcycle if the issue was not before the inventor. The issue was apparently not before either Slifka or Brown as they did not deal with it. What is meant herein is that neither Slifka, nor Brown deal with the side mounted device of this invention and therefore, they would not have been faced with the issue of the appropriate angle to place

the carrier relative to the long axis of the motorcycle. This obviousness would be in place only if one skilled in the art had the instant invention in front of them and such a determination had to be made based upon the inventive device. The issue does not arise in either of the cited references. Such rejection by the Examiner is based solely on hindsight after having the advantage of the disclosure of the instant specification and claims.

In view of the above, the applicant requests that the Board reverse the Examiner on all rejections.

Respectfully submitted,

A handwritten signature in cursive script that reads "Robert L. McKellar". The signature is written in black ink and is positioned above the printed name and contact information.

Robert L. McKellar
Reg. No. 26,002
(989) 631-4551

(C)(1)(viii) CLAIMS APPENDIX

1. A carrier for mounting to a motorcycle, the carrier for carrying a golf bag on the motorcycle, the motorcycle having passenger foot pegs, comprising: an elongated mounting frame member having an attachment means for attaching the mounting frame member to the motorcycle; a first support member attached to the mounting frame member so that the first support member extends laterally from the mounting frame member, at least a portion of the first support member being U shaped; a second elongated support member attached to the mounting frame member so that the second support member extends laterally from the mounting frame member, at least a portion of the second support member being U shaped, the second support member being spaced apart from the first support member so that when the mounting frame member is attached to a motorcycle the bottom of the U shaped portion of the first and second support members aligns with the passenger foot peg of the motorcycle so that when a golf bag is placed on the carrier, the golf bag is cradled in the U shaped portion of the first and second support members with the bottom of the golf bag resting on the passenger foot peg of the motorcycle and wherein the top of the golf bag is carried in a rearward reclining position.

2. The carrier of Claim 1, wherein the attachment means comprises a plurality of passageways through the mounting frame member, at least two of the passageways aligned with at least two fastener receiving means of the motorcycle so that the mounting frame member can

be attached to the motorcycle by fasteners extended through the passageways and secured by fastener receiving means.

3. The carrier of Claim 2, wherein the fasteners are bolts having threaded end portions and the fastener receiving means comprises a threaded portion of the motorcycle matched to the threaded end portions of the bolts.

4. The carrier of Claim 1, wherein the angle between the axis from the bottom of the U shaped portion of the first and second support members to the passenger foot peg and the longitudinal axis of the motorcycle is greater than one degree and less than thirty degrees when viewed from the top of the motorcycle when the carrier is mounted on a motorcycle so that when a golf bag is cradled in the U shaped portion of the first and second support members with the bottom of the golf bag resting on the passenger foot peg of the motorcycle, the upper portion of the golf bag angles toward the longitudinal axis of the motorcycle when viewed from the top of the motorcycle.

5. The carrier of Claim 2, wherein the angle between the axis from the bottom of the U shaped portion of the first and second support members to the passenger foot peg and the longitudinal axis of the motorcycle is greater than one degree and less than thirty degrees when viewed from the top of the motorcycle when the carrier is mounted on a motorcycle so that when a golf bag is cradled in the U shaped portion of the first and second support members with the bottom of the golf bag resting on the passenger foot peg of

the motorcycle, the upper portion of the golf bag angles toward the longitudinal axis of the motorcycle when viewed from the top of the motorcycle.

6. The carrier of Claim 3, wherein the angle between the axis from the bottom of the U shaped portion of the first and second support members to the passenger foot peg and the longitudinal axis of the motorcycle is greater than one degree and less than thirty degrees when viewed from the top of the motorcycle when the carrier is mounted on a motorcycle so that when a golf bag is cradled in the U shaped portion of the first and second support members with the bottom of the golf bag resting on the passenger foot peg of the motorcycle, the upper portion of the golf bag angles toward the longitudinal axis of the motorcycle when viewed from the top of the motorcycle.

7. The carrier of Claim 4, wherein the angle is in the range of from five degrees to fifteen degrees.

8. The carrier of Claim 5, wherein the angle is in the range of from five degrees to fifteen degrees.

9. The carrier of Claim 6, wherein the angle is in the range of from five degrees to fifteen degrees.

10. The carrier of Claim 3, wherein the threaded portion of the motorcycle comprises a saddlebag mounting bracket.

11. The carrier of Claim 10, wherein the angle between the axis from the bottom of the U shaped portion of the first and second support members to the passenger foot peg and the longitudinal axis of the motorcycle is greater than one degree and less than

thirty degrees when viewed from the top of the motorcycle when the carrier is mounted on a motorcycle so that when a golf bag is cradled in the U shaped portion of the first and second support members with the bottom of the golf bag resting on the passenger foot peg of the motorcycle, the upper portion of the golf bag angles toward the longitudinal axis of the motorcycle when viewed from the top of the motorcycle.

12. The carrier of Claim 11, wherein the angle is in the range of from five degrees to fifteen degrees.

(C)(1)(ix) EVIDENCE APPENDIX

(Not applicable)

(C)(1)(x) RELATED PROCEEDINGS APPENDIX



Certificate of Mailing under 37 CFR 1.8

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On: May 25, 2006

Signature

Molly Leins

Typed or printed name of person signing Certificate

989-631-4551

Registration Number, if applicable

Telephone Number

For USSN 10/646,138 in the name of Dean, entitled: GOLF BAG CARRIER FOR A MOTORCYCLE, coverletter for brief with authorization to charge deposit account 13-2492 the sum of \$250.00, 10 pgs. brief on appeal, 6 pgs. claims appendix (17 pgs. total), return receipt postcard.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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